

REMARKS

The Amendment filed on March 2, 2007, is considered non-responsive because it presents only claims drawn to a non-elected invention.

The Examiner cited MPEP §821.03, which states that claims added by amendment following action by the Examiner should be treated as indicated by 37 CFR §1.145, which imposes a restriction requirement where "applicant presents claims directed to an invention distinct from and independent of the invention previously claimed.

The Examiner states that the folding apparatus of the amended claims is distinct from the folding roll of the elected [i.e. the original] claims. Applicants disagree.

The amended claims (1-5 and 11-16) are directed to a combination (A folding apparatus) of which the folding roll is a part, i.e. a subcombination. See MPEP §806.05(a). According to MPEP §806.05(b), inventions are distinct only if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination s claimed for patentability (to show novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in another materially different combination.

Without addressing point (B), it is clear that the claimed combination (the folding apparatus) cannot meet point (A), because it requires the particulars of the subcombination for patentability. Accordingly, the requirements for distinctness are not met, and the requirement to correct the amended claims should be withdrawn.

Newly submitted claims 17-25 are limited substantially as respective claims 1-5 and 11-14, but are drawn to a folding roll.


If the Examiner persists with the restriction requirement, it is requested that compliance with MPEP §806.05(b) and MPEP §802.01 be fully explained (the latter section relates to the requirement that the inventions be independent).

Entry of the amendment, examination of all claims, and consideration of previously submitted arguments are earnestly solicited.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

COHEN PONTANI LIEBERMAN & PAVANE LLP

By 
F. Brice Faller
Reg. No. 29,532
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: June 25, 2007